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BELL, BOYD & LLOYD, LLC P. O. BOX 1135 CHICAGO, IL 60690-1135			EXAMINER TRAN, ELLEN C	
			ART UNIT 2134	PAPER NUMBER
DATE MAILED: 01/23/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/729,569

Applicant(s)

KUSAKABE ET AL.

Examiner

Ellen C. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>Nov'05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communication: amendment filed 14 December 2005, with an original application filed 04 December 2001, with acknowledgement of foreign application filing date of 08 December 1999.

2. Claims 1-3 and 5-26 are currently pending in this application. Claims 1, 7, 8, 14, and 21 are independent claims. Claims 1, 5, 7, 8, 9, 13, and 14, have been amended. Claims 21-26 are new. Claim 4, has been cancelled

3. Amendments to the claims are accepted.

Response to Arguments

4. Applicant's arguments with respect to claims 1-26 have been considered but have not been found persuasive. The previous rejection has been amended to account for modifications to the claims.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-3 and 5-26** are rejected under 35 U.S.C. 103(a) as being unpatentable over Sehr U.S. Patent No. 6,085,976 (hereinafter '976) in further view of Hoshino et al. U.S. Patent No. 6,088,680 (hereinafter '680).

As to independent claim 1, “A right-information distribution method comprising the steps of: generating right information and verification information for authenticating the validity of a portable electronic device when the right information is stored in said portable electronic device generating a right code, by encrypting the right information and the verification information” is taught in ‘976 col. 3, lines 1-40;

“wherein said right code is provided to a user offline” is shown in ‘976 col. 6, lines 1-14 (Note: it is inherent that “right code” has the same meaning as “account numbers”, “security key”, “access codes”, “validation codes”, “confirmation numbers”, “biometric information” known in the art that are provided to a user through many mechanisms such as in writing, live by a user, live by a sensor, which could be considered “offline” see”ACCESS CONTROL col. 18 lines 1-56) ;

“decrypting the right code inputted into the portable electronic device and using the verification information to authenticate the right information based on the decrypted right code; and storing the authenticated right information in said portable electronic device” is disclosed in ‘976 col. 6, lines 23-39;

“the generated right code being represented in at least one of an audible and visible form to input the right code into said portable electronic device by a user” is taught in ‘976 col. 6, lines 16-51;

the following is not taught in ‘976: **“communicating the right code communicated to said first portable electronic device by wirelessly coupling a second portable electronic device to said first portable electronic device, wherein said portable electronic device is operable independent of a connection status of said second portable electronic device”** however ‘680

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teaches “In light of the above problems, an object of this invention is to provide an automatic toll adjusting system, in addition to a storage medium with a radio communication function, a frequency converting apparatus, a writing apparatus, a settling apparatus, a depositing apparatus, and an inquiring apparatus all used for the automatic toll adjusting system, which system and apparatus can realize ticketless toll adjustment or toll adjustment requiring no stopping of a vehicle, allow the user to voluntarily select a toll pre-payment or a toll post-payment to improve service for the user of a toll road, and strengthen security to cope with wrongful, fraudulent, invalid or improper use or data falsification ... a first toll payment system for exchanging information with the storage medium by radio communication at a first predetermined frequency to automatically adjust a toll in a first toll payment system, and a toll adjusting gate employing a second toll payment system for exchanging information with the storage medium by radio communication at a second predetermined frequency to automatically adjust a toll in the second toll payment system” in col. 3, lines 6-31.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify a method taught in ‘976 to include a means to update the portable device independently of connection status. One of ordinary skill in the art would have been motivated to perform such a modification to speed the system of using portable devices see ‘680 (col. 1, lines 48 et seq.) “As an adjusting system for tolls, an unmanned entrance/exit tollhouse, or an entrance and exit toll houses both of which are unmanned, or a system in which toll adjustment necessitating no stopping of a passing vehicle at a tollhouse are not yet generalized. If such a system becomes possible, it will be helpful to solve traffic jams at the tollhouse, save labor, etc.”.

As to dependent claim 2, “wherein the right information includes information which permits admission to a predetermined place” is taught in ‘976 col. 4, lines 44-52.

As to dependent claim 3, “wherein said portable electronic device is an integrated circuit card” is taught in ‘976 col. 6, lines 16-18.

As to dependent claim 5, “wherein the storing of the right information is performed when said first portable electronic device and said second portable electronic device are electromagnetically coupled each other” is disclosed in ‘976 col. 6, lines 16-38.

As to dependent claim 6, “further comprising the steps of: inputting a first right code added to the right information, and an identification number for returning the right information to a source of the right information” is shown in ‘976 col. 6, lines 1-14;

“and after confirming the input first right code and the input identification number, confirming an offline providable second right code for returning the right information to said source of the right information, and invalidating said first right code” is disclosed in ‘976 col. 9, lines 15-19.

As to independent claim 7, “A right-information distribution method for transferring right information from a first portable electronic device to a second portable electronic device” is taught in ‘976 col. 9, lines 15-19;

“the right-information distribution method comprising the steps of: generating the right information and verification information for authenticating the validity of said first portable electronic device when the right information is stored in said first portable electronic device; generating a first right code, by encrypting the right information and the verification information” is disclosed in ‘976 col. 3, lines 1-40;

“wherein said right code is provided to a user offline” is taught in ‘976 col. 6, lines 1-14;

“enabling the user to wirelessly input the first right code and identification number of said second portable electronic device directly into said first portable electronic device, the generated right code being represented in at least one of an audible and visible form to input the right code into said portable electronic device by a user” is disclosed in ‘976 col. 6, lines 16-51;

“confirming the wireless input of the first right code and the wireless input of the identification number; invalidating the first right code and generating a second right code, which is provided offline” is shown in ‘976 teaches in col. 21, lines 12-27;

“enabling the user to input the second right code into said second portable electronic device of a second connection status of said second portable electronic device, the generated right code being represented in at least one of an audible and visible form to input the right code into said second portable electronic device by a user” is disclosed in ‘680 col. 3, lines 6-31;

“decoding the offline-provided second right code into the portable electronic device and authenticating the decoded second right code; and storing, the right information included in the authenticated second right code” is disclosed in ‘976 col. 6, lines 23-39.

As to independent claim 8, **“An information distribution system comprising: a portable electronic device; and an information management apparatus configured to store (i) right information that indicates a predetermined right and (ii) device information**

corresponding to said portable electronic device that indicates, to whom a right belongs” is taught in ‘976 col. 3, lines 1-40;

“wherein said information distribution system manages the location of said predetermined right by updating the right information stored by said information management apparatus and the device information indicating to whom said right: belongs; said information management apparatus comprises: information holding means for holding the right information” is shown in ‘976 col. 5, lines 11-54;

“access means for recording the transfer of said predetermined right to said portable electronic device by accessing said information holding means and updating the right information held by said information holding means” is shown in ‘976 col. 5, lines 48-67;

“encryption means for generating encrypted information by using a code unique to said portable electronic device to encrypt the device information indicating to whom said right belongs to be in an offline providable form; and information providing means for providing said portable electronic device with the encrypted information so that the encrypted information passes through an offline channel at least once; and said portable electronic device comprises: a power supply; is disclosed in ‘976 teaches in col. 6, lines 1-51.

“input means for wirelessly accepting the input of the encrypted information into said portable electronic device independently of a connection status of said portable electronic device, the generated encrypted information represented to a user in at least one of an audible and visible form; decryption means for decrypting the encrypted information using said unique code and outputting the information indicating to whom said right

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belongs; recording means for recording the output information indicating to whom said right belongs; and information output means for using a predetermined access means to output the recorded information indicating to whom said right belongs” is taught in ‘680 col. 3, lines 6-31.

As to dependent claim 9, is substantially similar to claim 2 and is rejected along the same rationale.

As to dependent claim 10, “**wherein said information management apparatus executes billing in response to the provision of the encrypted information by said information providing means”** is taught in ‘976 col. 3, lines 56-67.

As to dependent claim 11, “**wherein: said portable electronic device comprises: information generating means for generating information for requesting the transfer of said right based on the information recorded in said recording means”** is shown in ‘976 col. 9 lines 15-19;

“encryption means for generating encrypted transfer information by using a code unique to encrypt the information for requesting the transfer of said right so that the encrypted transfer information is provided offline; control means for controlling the accessing of the information recorded in said recording means in response to the encryption by said encryption means; and output means for outputting the encrypted transfer information so that the encrypted transfer information passes through an offline channel at least once; and said information management apparatus further comprises a decryption means for decrypting the encrypted transfer information, and updates right information which corresponds to the output of said decryption means by using said access

means to access said information holding means in response to the output of said decryption means” is disclosed in ‘976 col. 6, lines 1-52.

As to dependent claim 12, “wherein said information management apparatus executes billing in response to the provision of the encrypted information by the information providing means, and changes the billing in response to the encrypted transfer information” is taught in ‘976 col. 3, lines 56-67.

As to dependent claim 13, “wherein: said portable electronic device comprises: encryption means for generating second encrypted information based on the information recorded in said recording means by using a code unique to a second portable electronic device so that the second encrypted information is provided offline; control means for controlling the accessing of the information recorded in said recording means in response to the encryption by said encryption means; and output means for outputting the second encrypted information so that the second encrypted information is provided to the other portable electronic device” is shown in ‘976 col. 9, lines 15-19;

“after passing through an offline channel at least once; and the second portable electronic device performs the processing of the second encrypted information, which is identical to the processing of the encrypted information by said portable electronic device” is shown in ‘976 col. 5, line 12 through col. 6, line 52.

As to independent claim 14, “An information management method for, updating right information held by an information management apparatus and for recording in a portable electronic device information indicating to whom said right belongs, managing said right so as to be exercised when said portable electronic device is with a user, wherein

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said information management method controls said information management apparatus to perform the steps of” is taught in ‘976 col. 3, lines 1-40;

“generating encrypted information to be in an offline providable form using a code unique to said portable electronic device to encrypt the information indicating to whom said right belongs” is shown in ‘976 col. 6, lines 1-14;

“providing the encrypted information so that the encrypted information passes through an offline channel at least once; and” is disclosed in ‘976 col. 6, lines 23-39;

“enabling the wireless input of said encrypted information into said portable electronic device independently of a connection status of said portable electronic device, the generated encrypted information represent in at least one of an audible and visible form” is taught in ‘680 col. 3, lines 6-31.

As to dependent claim 15, “wherein the billing is performed in response to the provision of the encrypted information” is disclosed in ‘976 teaches in col. 3, lines 57-67.

As to dependent claim 16, “wherein said information management method controls said portable electronic device to perform the steps of generating encrypted transfer information by using a unique code to encrypt information for requesting the transfer of said right so that the encrypted transfer information is provided offline; and preventing the information indicating to whom said right belongs from being output, and transmitting the encrypted transfer information to said information management apparatus so that the encrypted transfer information passes through the offline channel at least once” is disclosed in ‘976 col. 6, lines 1-15.

As to dependent claim 17, “wherein said information management method controls said image management apparatus to perform the steps of executing a billing process in response to the provision of the encrypted information; and changing said billing process in response to the encrypted transfer information” is taught in ‘976 col. 3, lines 56-67.

As to dependent claim 18, “wherein said information management method controls said portable electronic device to perform the steps of: generating second encrypted information based on the information indicating to whom said right belongs by using a code unique to another portable electronic device so that the second encrypted information is provided offline; and providing the second encrypted information to the other portable electronic device so that the second encrypted information passes through the offline channel at least once; and outputting the second encrypted information and preventing the information indicating to whom said right belongs from being output” is shown in ‘976 col. 5, line 12 through col. 6, line 52.

As to dependent claims 19 and 20, these claims are substantially similar to claims 2 and 3 therefore they are rejected along the same rationale.

As to independent claim 21, “A method of distributing information, the method comprising: providing a first portable device; generating right information representative of a user right; generating verification information for authenticating the validity of the right information and the first portable electronic device; storing the right information and the verification information on the first portable device” is taught in ‘976 col. 3, lines 1-40;

“encrypting the right information and the verification information to generate a right code” is shown in ‘976 col. 6, lines 1-39;

“providing a second portable device, the second portable device configured to wirelessly communicate with the portable device; inputting the right code into the second portable device and wirelessly communicating decrypting the right information and the verification information based on the right code communicated to the first portable electronic device” is disclosed in ‘976 col. 9, lines 15-19;

“and utilizing the verification information to authenticate the right information stored on the first portable electronic device; and storing the authenticated right information on the first portable electronic device” is shown in ‘680 col. 3, lines 1-31.

As to dependent claim 22, “further comprising providing an indication of the right code to a user” is disclosed in ‘976 col. 6, lines 39-51.

As to dependent claim 23, “wherein the indication is an audible indication or a visible indication” is disclosed in ‘976 col. 6, lines 39-51.

As to dependent claim 24, “wherein said first portable electronic device is an integrated circuit card and said second portable electronic device includes an input device” is taught in ‘976 col. 6, lines 16-39.

As to dependent claim 25, “wherein providing the second portable device include electromagnetically coupling the second portable device to the first portable device” is shown in ‘976 col. 6, lines 16-39 (Note the examiner interprets “electromagnetically coupling” to have the same meaning as “loaded into (write operation) the card via a card read/write device).

As to dependent claim 26, wherein electromagnetically coupling the second portable device to the first portable device provides driving power to the second portable device” is

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disclosed in '976 col. 6, lines 16-39 (Note when a smartcard is utilized with other equipment "on-line modus" power is provided by the other equipment).


Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen C Tran whose telephone number is (571) 272-3842. The examiner can normally be reached from 6:00 am to 2:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (571) 272-3799. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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17 January 2006


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